Remarks.

The modification to the specification at page 10 line 13 merely corrects a typographical error.

The amendment to claims 1, 17, and 31 adds a limitation that is not taught or disclosed in the prior art, that being the is automatic generation of reports to the service provider based on the evaluation data. This amendment is supported in the specification at page 9, line 17 through page 10, line 5.

Claim 39 has been amended to remove the vagueness objection and to add a limitation not taught in the prior, but supported in the specification.

Response to Claims Rejections.

Rejection of Claims 39-53 under 35 USC § 112.

Rejection of claim 39 is respectfully traversed to the extent such rejection applies to the newly amended independent claim 39 for the following reasons:

Claim 39 was amended by replacing the words, "service provider" with the words, "service evaluator," which removes the vagueness as noted by the Examiner, the diligence of whom is greatly appreciated.

The examiner has rejected claim 44, asserting that the last two lines are vague. Applicant respectfully traverses such statement. Claim 44 reads:

"44. The method of claim 42 wherein the step of the evaluation processor providing correlated information to the management of the service provider includes the step of the evaluation processor providing the manager selected service provider information."

Page 10, lines 10-22 specifies the types of service provided information provided by the evaluation processor, and also specifies how such information may be used and correlated with other service provider information. In the event that the Examiner continues to consider claim 44 to be vague, Applicant hereby requests that Examiner more explicitly state why he believes claim 44 to be vague.

Claims 40-43 and 45-53 were not rejected under 35 USC § 112. Such claims depend on independent claim 39, which Applicant deems in condition for allowance. Therefore, Applicant deems claims 40-43 and 45-53 to be in condition for allowance.

Rejection of claims 39-53, 31-38 under 35 U.S.C. §103(a) as being unpatentable over Fuerst (US Patent 6,189,029).

Rejection of claim 39 under 35 U.S.C. §103(a) as being unpatentable over Fuerst.

Rejection of claim 39 under 35 U.S.C. §103(a) as being unpatentable over Fuerst is respectfully traversed to the extent that such rejection applies to the currently amended

independent claim 39 for the following reasons:

Analysis of U.S. Patent No. 6,189,029 to Fuerst.

Fuerst teaches a system for creating an electronic surveys and the automatic collection and tabulation of survey results on a website. The survey results are collected in a relational database as a user completes the survey. Subsequently a survey creator may access the survey result to manipulate the data (see page 2, lines 20-47). First, Fuerst does not teach the identification of a particular survey respondent. Fuerst only teaches the identification numbers for permitted surveys for the purposes of allowing access by the survey creator to the script of the web-based survey. The surveys of Fuerst are broadly made available to a number of parties, but the identities of the respondents to the survey are not known. The system of Fuerst has absolutely no idea of who the respondent to the survey was, and there is absolutely no teaching of any method of matching the provision of services to any particular service provider or individual (Exhibit 1, Declaration of Todd F. Seiple, paragraphs 4(a)(b)). Therefore, there is no disclosure or teaching in Fuerst as to the performance evaluation of the service provider or employee, or that any such evaluation would be beneficial or desired.

Second, the only automatic function of Fuerst is the collection and tabulation of survey results corresponding to user responses. Fuerst only teaches that the user may apply statistical tools or other analytical software applications to data mine the tabulated results. Nothing is done based on survey results. And at page 3, line 20 Fuerst teaches a method of querying the results of the surveys. Fuerst does not teach a method of automatically generating reports based on the survey results (Seiple Dec'l., paras. 4(c)-(e)).

> In the Office Action, the Examiner stated:
> "As for claim 39, FUERST discloses a method for assisting the management of a service provider by conducting an automatic survey and report system comprising the steps of: creating a survey using a evaluation processor (survey creator), contacting the service evaluator (employee) for obtaining data about the provider service (company's medical plan, etc.,), providing correlated information from the obtained data to the service provider manager (plan's Administrator or Corporate) whereby the manager may evaluate the service (medical plan) provided by the service provider (company).

Applicant respectfully traverses such statement to the extent such system provides a report system. For support of the statement, the Examiner cites col. 1. lines 40-45 (or 1:40-45), 2:20-65, 7:65-69, 8:1-30, 9:20-60).

The PTO has the burden under section 103 to establish a prima facie case of obviousness. See In re Piasecki , 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-87 (Fed. Cir. 1984). It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Lalu, 747 F.2d 703,

705, 223 USPQ 1257, 1258 (Fed. Cir. 1984); see also <u>Ashland Oil, Inc. v. Delta Resins & Refractories, Inc</u>., 776 F.2d 281, 297 n.24, 227 USPQ 657 , 667 n.24 (Fed. Cir. 1985); <u>ACS Hosp. Sys., Inc. v. Montefiore Hosp</u>., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). In order to find claims 39 to be obvious, the Examiner must show that there must have been something present in those teachings to suggest to one skilled in the art that the claimed invention was obvious, as stated in <u>In re Bergel</u>, 48 C.C.P.A. 1102, 292 F.2d 955, 956-57, 130 USPQ 206, 208 (CCPA 1961); <u>In re Sponnoble</u>, 56 C.C.P.A. 823, 405 F.2d 578, 585, 160 USPQ 237, 244 (CCPA 1969). There is no such teaching in Fuerst of the generation of any reports. Fuerst merely provides survey data in a tabulated form (Seiple Dec'l., para. 4)). The survey provider must access the website in order to view the data. No report system is provided. Further, there is no disclosure of an automatic system for generating reports to the service provider. Therefore, there is no teaching in Fuerst that would make it obvious to one of ordinary skill in the art that a report would be generated to the service provider (Seiple Dec'l., para. 4(e)). If the Examiner believes that there is some teaching in Fuerst to suggest any report system, then Applicant respectfully requests the Examiner to identify such in the specification of Fuerst. Applicant respectfully reminds the Examiner of the following:

> "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. <u>W.L. Gore & Associates, Inc., v. Garlock, Inc</u>., C.A.F.C. 721 F.2d 1540; 220 U.S.P.Q. (BNA) 303 (1983)."

<u>Rejection of claims 40-53 under 35 U.S.C. §103(a) as being unpatentable over Fuerst</u>.

Claims 40-53 are dependent upon currently amended independent claim 39, which claim 39 Applicant now deems in condition for allowance. Since claim 39 is now not considered to be obvious to one of ordinary skill in the art, the combination of claim 39 with dependent claims 40-53 cannot be considered to be obvious to one of ordinary skill in the art. Therefore, Applicant considers that claims 39-53 are now in condition for allowance.

<u>Rejection of claim 31 under 35 U.S.C. §103(a) as being unpatentable over Fuerst</u>.

Rejection of claim 31 under 35 U.S.C. §103(a) as being unpatentable over Fuerst is respectfully traversed to the extent that such rejection applies to the newly amended independent claim 31 for the following reasons:

The Examiner has grouped independent claim 31 with the argument of obviousness for the dependent claims 40-53 to independent claim 39, stating:

> "As for claims 41-43, 31, 45-46, the teaching of assigning of unique identifier to the evaluator or processor is fairly taught by FUERST on 7:65 to 8:30 to accurately monitor of the survey and provide specific and effective responses to the evaluator to ensure good service. The various assigning of the identification to other groups or evaluation processor would have been

obvious as mere duplication of the ID assigning process to further improve the effectiveness of the survey and response."

Applicant does not dispute that "the identification to other groups or evaluation processor would have been obvious as mere duplication of the ID assigning process to further improve the effectiveness of the survey and response." At column 7, line 65, Fuerst discloses:

"Referring now to FIG. 9, when the survey creator desires to obtain the results of the survey, the creator will enter the appropriate group ID to obtain the list of surveys that the creator can view or access."

Fuerst only discloses the assignment of ID numbers to the surveys themselves. As noted above, Fuerst does not disclose the use of ID numbers for any other purpose than to identify surveys for the purpose of the creator accessing the script of the survey and for the survey creator to subsequently access the data. However, Fuerst does not suggest or teach that ID numbers could be assigned to the service evaluator. Currently amended claim 31 provides

"31. A method for assisting in the management of a service provider having at least one manager, at least one employee and at least one service evaluator, the method comprising the steps of:

a.   the service evaluator contacting an evaluation processor, the evaluation processor for obtaining evaluation data from the service provider and the at least one service evaluator;

b.   the service provider identifying to the evaluation processor unique **identifiers of the at least one service evaluator, the at least one employee and the service provider;**

c.   the evaluation processor obtaining evaluation data from the at least one service evaluator, the evaluation data **including the unique service evaluator identifier;**

d.   the evaluation processor correlating the unique service evaluator identifier provided by the service evaluator with the unique service evaluator identifier provided by the service provider, and using the evaluation data to assess the performance of the at least one employee with the service evaluator; and

e.   the evaluation processor providing correlated information from the evaluation data to the manager whereby the manager may evaluate the service provided by the at least one employee to the at least one service evaluator." **(Emphasis Added)**

The critical elements of claim 1 include the identification of the service evaluator, the employee and the service provider. Fuerst does not suggest that the assigning of ID numbers to the service evaluator would be desirable or beneficial. It would not be obvious

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to a person of ordinary skill in the art that Fuerst could be adapted to provide a means for the persons surveyed to be identified (Dec'l. Seiple, para. 4(a)); nor would it be obvious to a person of ordinary skill in the art that Fuerst could be adapted to provide a means for an identified employee of the service provider be evaluated (Dec'l. Seiple, para. 4(b)).

The Examiner states that Fuerst also discloses:
> " contacting the service evaluator (employee) for obtaining data about the provider service (company's medical plan, etc.,)"

Such is not entirely accurate. Fuerst discloses, at column 2, line 50 "a survey containing specific questions regarding employee use and experiences in dealing with the plan's administrators may be generated by a creator and posted to the Web page. And at column 2, line 56, "By broadcasting a company-wide electronic mail message, the Web address and notice of the availability of the survey is transmitted to the intended survey user. The only contacting that the evaluation processor (company) makes is to make the service evaluator (employee) aware of the existence of the survey. It is then up to the employee to contact the website.

Rejection of claims 32-38 under 35 U.S.C. §103(a) as being unpatentable over Fuerst.
Claims 32-38 are dependent upon currently amended independent claim 31, which claim 31 Applicant now deems in condition for allowance. Since claim 31 is now not considered to be obvious to one of ordinary skill in the art, the combination of claim 31 with dependent claims 32-38 cannot be considered to be obvious to one of ordinary skill in the art. Therefore, Applicant considers that claims 32-38 are now in condition for allowance.

Rejection of claims 1-16, and 17-30 under 35 U.S.C. §103(a) as being unpatentable over Fuerst (US Patent 6,189,029) in view of Smith (US Patent 2002/0123925).
The Examiner states:
> "It would have been obvious to modify the management/employee survey (internally) of FUERST to include other known monitoring of employee's performance with respect to customer (externally) as taught by SMITH so as to monitor proper employee's performance and reward if desired."

Analysis of U.S. Patent Application 2002/0123925 of Smith.
Smith discloses an internal survey system for monitoring and rewarding call center agents. Smith discloses a method and system wherein the performance of the service provider (center agent) is evaluated by an evaluation processor (performance monitoring system). Smith does not disclose the service evaluator contacting an evaluation processor, Smith discloses the evaluation processor contacting the service evaluator. At column 1, paragraph 1006, Smith states:
> "The automated call distribution system monitors the performance of the agents via automated survey questions to the callers."

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Fuerst (Seiple Del'l. para. 5(a)), as Fuerst does not disclose any employee performance monitoring (Seiple Del'l. para. 4(b)). There is no teaching in Smith that the combination of Smith and Fuerst would be either beneficial or desired (Seiple Dec'l., para. 6). Further, a combination of Fuerst and Smith would not result in the claims of the instant invention.

<u>Rejection of claims 2-16 and 18-30 under 35 U.S.C. §103(a) as being unpatentable over Fuerst in view of Smith</u>.

Claims 2-16 and 18-30 are dependent upon currently amended independent claims 1 and 17, respectively, which currently amended claims 1 and 17 Applicant now deems in condition for allowance. Since claims 1 and 17 are now not considered to be obvious to one of ordinary skill in the art, the combination of claim 1 with dependent claims 2-16, and the combination of claim 1 with dependent claims 18-30, cannot be considered to be obvious to one of ordinary skill in the art. Therefore, Applicant considers that claims 2-16 and 18-30 are now in condition for allowance.

Conclusion.

Applicant has amended claims 39 and 44 to remove the rejections based on 35 U.S.C. §112. Applicant has amended independent claims 1, 17, 31, and 39 to avoid the rejections based under 35 U.S.C. §103(a). All of such amendments are supported in the specification. Applicant has shown that the Fuerst does not disclose or teach the critical limitations of the currently amended claims in that Fuerst does not contemplate the use of service provider data including identification data. Applicant further has shown that the system of Smith was not pertinent to Fuerst, and that there would have been no teaching or incentive by one of ordinary skill in the art to combine Fuerst and Smith.

Applicant believes that all pending claims of the application are in condition for allowance. Reconsideration and allowance of the claims is respectfully requested.

Respectfully submitted,

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Dated: September 0, 2003

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